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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/520,321

10/27/2005

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EXAMINER

MCPHERSON, JOHN A

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

01/15/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/520,321	Applicant(s) TATSUZAWA ET AL.	
	Examiner John A. McPherson	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29,30 and 33-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-42,44,46,48,50,53,56,59-62,65,66,69,70,73 and 74 is/are allowed.
- 6) ☒ Claim(s) 29,30,33-36,43,45,47,49,51,52,54,55,57,58,63,64,67,68,71 and 72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/23/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the Amendment filed 9/29/09.
 2. The Amendment filed 9/29/09 successfully overcomes the objection and rejection set forth in paragraph 2 and 3, respectively, of the Office Action mailed 4/28/09.
- Accordingly, the objection and rejection are withdrawn.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 29, 30, 33, 51, 54 and 71 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 4 and 5 of U.S.

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Patent No. 6,826,001 for the reasons of record as set forth in paragraph 1 of the Office Action mailed 4/28/09, and as further discussed below.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 29, 30, 33-36, 43, 45, 47, 49, 51, 52, 54, 55, 57, 58, 63, 64, 67, 68, 71 and 72 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 02/067022 [reference B2 of the Information Disclosure Statement filed 5/10/06] (WO '022), utilizing US 6,826,001 (US '001) as an English-language equivalent, for the reasons of record as set forth in paragraph 4 of the Office Action mailed 4/28/09, and as further discussed below.

5. Claims 29, 30, 33-36, 43, 45, 47, 49, 51, 52, 54, 55, 57, 58, 63, 64, 67, 68, 71 and 72 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 2003-161828 [reference B3 of the Information Disclosure Statement filed 5/10/06] (JP '828) for the reasons of record as set forth in paragraph 5 of the Office Action mailed 4/28/09, and as further discussed below.

Allowable Subject Matter

6. Claims 37-42, 44, 46, 48, 50, 53, 56, 59-62, 65, 66, 69, 70, 73 and 74 are allowed.

Response to Arguments

7. Applicant's arguments filed 9/29/09 have been fully considered but they are not persuasive.

With respect to the obvious double patenting rejection, Applicant argues that the substantive amendments executed to independent claim 29 render that claim, and all claims depending therefrom, non-obvious over US 6,826,001. However, US 6,826,001 claims a color filter comprising a zinc phthalocyanine pigment wherein 9 or more halogen atoms bonded to the benzene rings in one phthalocyanine molecule are bromine atoms (see claim 5, depending from claim 2). It is the position of the Examiner that the small number of pigments presented in claim 5/2/1 of the patent (i.e. zinc phthalocyanine pigments having 9, 10, 11, 12, 13, 14, 15 and 16 bromine atoms) include brominated zinc phthalocyanine green pigments containing less than 13 bromides on average per one molecule capable of expressing a region of xy-chromaticity coordinate enclosed by Equations 7, 8 and 9 (e.g. zinc phthalocyanine pigments having 10 or 11 bromine atoms - see paragraph [0089] of the present specification), because both the present invention and the patented invention are drawn to the same pigments, and the xy-chromaticity coordinate of a pigment is a material-dependent property.

With respect to the 35 USC 102 rejections over WO '022 and JP '828, Applicant argues that $\text{ZnPcBr}_{14}\text{Cl}_1\text{H}$ in WO '022 or $\text{ZnPcBr}_{13}\text{Cl}_2\text{H}$ in JP '828 can display neither that xy-chromaticity coordinate region enclosed by the Equations 1, 2 and 3 (region A) nor the xy-chromaticity coordinate region enclosed by the Equations 7, 8 and 9 (region B). However, it is the position of the Examiner that the disclosures of WO '022 and JP '828 are not limited to these two pigments. Specifically, WO '022 discloses a color filter comprising a zinc phthalocyanine pigment wherein 9 or more halogen atoms bonded to the benzene rings in one phthalocyanine molecule are bromine atoms (see claim 5 of WO '022), and JP '828 discloses a color filter comprising a pigment dispersed resist, wherein the pigment dispersion contains halogenated metal phthalocyanine having specific metal atoms other than copper, wherein exemplified metal atoms include Zn and the phthalocyanine preferably has 8 or more bromine atoms and 1 or more chlorine atoms. See paragraph [0014] of the computer-generated translation.

It is the position of the Examiner that the small number of pigments disclosed in the preferred embodiments of WO '022 and JP '828 (i.e. zinc phthalocyanine pigments having 9, 10, 11, 12, 13, 14, 15 or 16 bromine atoms in WO '022, and zinc phthalocyanine pigments having 8, 9, 10, 11, 12, 13, 14 or 15 bromine atoms in JP '828) anticipate the brominated zinc phthalocyanine green pigments containing less than 13 bromides on average per one molecule capable of expressing a region of xy-chromaticity coordinate enclosed by Equations 7, 8 and 9 of the presently claimed invention (e.g. zinc phthalocyanine pigments having 10 or 11 bromine atoms - see paragraph [0089] of the present specification), because both the present invention and

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the patented invention are drawn to the same pigments, and the xy-chromaticity coordinate of a pigment is a material-dependent property.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (571) 272-1386. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John A. McPherson/
Primary Examiner, Art Unit 1795

JAM
1/14/10